

REMARKS

This Amendment is being filed in response to the Office Action that was mailed August 4, 2004. Claim 1 of the Amendment filed June 24, 2003 inadvertently did not include underlining for the phrase "a front side and a back side". This underlining has been added by this Amendment and any inconvenience is regretted.

It is requested that the Examiner reconsider the holding of the Amendment of May 19, 2004 as being non-responsive to the Office Action mailed August 27, 2003. The Amendment that was filed January 2, 2004 was held to not be fully responsive to the Office Action of August 27, 2003 and the applicant was given one month to supply the correction to the prior Amendment of January 2, 2004 in an Office Action that was mailed April 22, 2004. That Office Action raised three issues regarding claims 1, 44 and 45 of an Amendment dated July 27, 2003 which did not appear to relate to the present application based on the content and on the mention of claims 44 and 45 which were not in the present application. After reviewing the claims of the Amendment of January 2, 2004, errors were detected in claims 1 and 7 which were corrected by adding underlining in a good faith effort to fully respond to the use of an improper form of amendment. One error was not detected which was noted in the Office Action of August 4, 2004. The Office Action of April 22, 2004 did not point to any specific error in the Amendment of January 2, 2004 and for this reason, it is believed that the response filed on May 19, 2004 was a good faith effort to respond to the Office Action of April 22, 2004 and the response should not be deemed non-responsive.

Attached hereto is a copy of an Official Gazette Notice of September 23, 2003. This Notice states that if an amendment includes non-compliant amendments, a Notice of Non-Compliant Amendment should be mailed. There is no direction to hold such

an amendment non-responsive under 37 CFR§1.111. For these reasons, it is requested that the holding, that a non-responsive amendment was filed, be withdrawn.

In paragraph 3 of the Office Action of August 27, 2003, claims 1-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yasuda et al.

Reconsideration is requested.

The Yasuda et al. reference discloses a biaxially oriented sheet, an adhesive layer under the coupon, deadened with a patterned silicone layer and a perforated border around the edges of the coupon to facilitate coupon removal. In contrast, the label called for by claims 1-17 of the Applicants' invention, as filed, uses a monoaxially-oriented film and an adhesive layer under the couponable area which does not require scoring and/or perforations. This provides an easily removable coupon free of wrinkling, creasing and blistering.

In contrast, the entire tenor of the Yasuda et al. reference is to select and use a biaxially-oriented film. Yasuda et al.'s base layer comprises a biaxially stretched film, (Abstract), prepared by first stretching in the machine direction then stretching in the transverse direction (Specification, Col. 5, lines 10-23).

Yasuda et al. suggest, in passing, that where base layer 2 is a composite film, it can comprise a biaxially stretched core layer and a uniaxially stretched paper layer, without however teaching the orientation of the latter, ie., machine direction or transverse direction.

All of the claims now point out that a continuous layer of adhesive is on the outer back surface of the label. The claims also call for stretching in the machine direction only, thereby clearly excluding Yasuda et al.'s teachings to stretch in two directions.

Furthermore, Yasuda, et al., state, with reference to Figures 1 and 2:

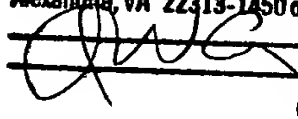
Early and favorable action is earnestly requested.

Respectfully Submitted



James V. Costigan
Registration No.: 25,669

Hedman & Costigan
1185 Avenue of the Americas
New York, NY 10036
212) 302-8989

I hereby certify that this
correspondence is being
deposited with the United States Postal Service as
first class mail in an envelope addressed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450 on 8/10/04


"As previously explained, adhesive layer 3 is not formed on the entire back side of base layer 2. That is, it is applied to the part except less adhesive zone 4 where adhesive layer 3a is formed at a density of not more than 50%." (Col. 5, lines 52-56); and

"Alternatively, the adhesive layer comprising adhesive layer 3b partitioned by less adhesive layer 3a can be formed by applying an adhesive layer on the entire back side of base layer 2 by extrusion and applying a parting agent, such as a silicone resin, in a dot form, a stripe form, a check form, etc, to the adhesive layer corresponding to coupon 5" (Col. 6, lines 20-26).

As the Applicants herein and their disclosure explain, it is critical to the present invention that the adhesive layer is always put down before a continuous layer of adhesive is put down overall. This results in a structure unlike Yasuda et al's Figure 1 and 2, in which the 3b's are interrupted by 3a, rendering the adhesive layer discontinuous. Thus claims 7 and 24 and their dependents are patentable over Yasuda for the further reason that they define a structural difference and not only differ merely by the particular material used or the measurements thereof.

The rejection over Yasuda et al should be reconsidered and withdrawn because the language of the claims as amended calls for features which could not have involved a mere matter of obvious design choice.

United States Patent and Trademark Office OG Notices: 23 September 2003

Amendments Permitted under the
Revised Amendment Practice and
Treatment of Non-Compliant Amendments

SUMMARY:

Amendments submitted prior to July 30, 2003 in compliance with the previous version of 37 CFR 1.121 or the revised version promulgated in the Notice of Final Rule Making: Changes To Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 38611 (June 30, 2003) (Revised Amendment Practice) will be accepted. Amendments filed on or after July 30, 2003, must be submitted in compliance with revised 37 CFR 1.121. The previously announced limited waivers permitting submission of amendments in the voluntary revised amendment format terminate on July 29, 2003. If a preliminary amendment or a reply under 37 CFR 1.111 filed on or after July 30, 2003 includes one or more non-compliant sections, applicant will be notified via a Notice of Non-Compliant Amendment that the non-compliant section(s) needs to be re-submitted in compliant form within a period set by the Office.

BACKGROUND

The United States Patent and Trademark Office (Office) previously announced a prototype program to evaluate the electronic image processing of patent applications using the image file wrapper system (IFW). See USPTO Announces Prototype of Image Processing, 1265 Off. Gaz. Pat. Office 87 (December 17, 2002). The notice included a limited waiver of 37 CFR 1.121 (available in applications being examined in the prototype program) which permitted amendments to be submitted in a voluntary revised amendment format. The limited waiver was later extended to all applications. See Amendments in a Revised Format Now Permitted, 1267 Off. Gaz. Pat. Office 106 (February 25, 2003). The Office revised its rules of practice to implement image file wrapper processing, including the Revised Amendment Practice, taking into account public comments, in the above-noted notice of final rule making, which is effective on July 30, 2003. Many members of the public have requested that the Office permit amendments to be submitted in compliance with the revised version of 37 CFR 1.121 before the effective date of July 30, 2003 in order to provide for a smoother transition to the new practice. This Notice adopts the suggestion.

WAIVER OF 37 CFR 1.121 UNTIL JULY 29, 2003

The provisions of 37 CFR 1.121(a), (b), (c) and (d) are hereby waived for amendments to the claims, specification, and drawings, filed before July 30, 2003 in all applications where the amendments comply with 37 CFR 1.121 effective on July 30, 2003. Note: The revised amendment rules (and this waiver) do not apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 and 37 CFR 1.530(d)-(k), respectively.

TREATMENT OF NON-COMPLIANT AMENDMENTS

All amendments received by the Office on or after July 30, 2003 must be in compliance with the rules as required by the Revised Amendment Practice. This practice requires the submission of an amendment document that includes separate sections for amendments to

the claims, drawings, specification and abstract, each beginning on a new sheet of paper. If an amendment is received as a preliminary amendment or as a bona fide reply under 37 CFR 1.111, that has compliant amendments to one or more separate section(s), but also includes one, or more, separate section(s) with non-compliant amendments, the Office will mail a Notice of Non-Compliant Amendment requiring correction to the non-compliant section(s) within a time period set by the Office. When making corrections, applicant should just resubmit the needed corrected section(s), and correspondingly, should not resubmit the entire amendment document. For example, if the amendment included compliant amendments to the specification and claims, and non-compliant amendments to the drawings, a notice requiring resubmission of compliant amendments to the drawings would be sent. In reply to the notice, applicant should only submit a compliant amendment to the drawings, and not the previously compliant amendments to the specification and claims. If any additional, or further, amendments to the claims are desired, the changes must be made relative to the previous compliant amendment to the claims. The Office will consider both the previous compliant amendment to the claims, and the supplemental compliant amendment to the claims, after the Office receives the compliant amendment to the drawings.

An amendment submitted on or after July 30, 2003 as part of a reply after the close of prosecution (e.g., as a reply under 37 CFR 1.116) that is not compliant with the Revised Amendment Practice will not act to toll the outstanding time period. See 37 CFR 1.135(c). A notice (e.g., an advisory action) may be mailed by the Office specifying which section(s) of the amendment was not in compliance with the Revised Amendment Practice, but no new time period will be given to provide a compliant section.

FOR FURTHER INFORMATION CONTACT:

Questions concerning this notice may be submitted to Joseph Narcavage, Elizabeth Dougherty or Eugenia Jones by e-mail at joseph.narcavage@uspto.gov or by telephone at (703) 305-1622.

July 11, 2003

STEPHEN G. KUNIN
Deputy Commissioner for
Patent Examination Policy